

### **REMARKS**

Entry of this Amendment is proper under 37 C.F.R. § 1.116, because the Amendment places the application in condition for allowance for the reasons discussed herein; does not raise any new issue requiring further search and/or consideration, because the amendments amplify issues previously discussed throughout prosecution and during the interview; does not present any additional claims; relates to matters of form rather than substance, because the added language was already present in the claims, and places the application in better form for an appeal should an appeal be necessary. The Amendment is necessary and was not earlier presented because it is made in response to arguments raised in the final rejection. Entry of the Amendment, reexamination and further and favorable reconsideration of the subject application in light of the following remarks, pursuant to and consistent with 37 C.F.R. § 1.116, are thus respectfully requested.

#### **1. Interview**

Applicants' representative held and interview with Examiner Baskar on August 31, 2006 to discuss all the outstanding rejections. As required in the Interview Summary, Applicants provide herewith comments regarding the interview. Amendments were discussed for certain claims which would place additional claims 1-9 in condition for allowance and overcome the rejections under 35 U.S.C. § 112, first paragraph. Applicants also discussed the cited art against certain of the claims.

#### **2. Status of the Claims**

As noted in the Office Action Summary, claims 1-13, 17-20, and 32-34 are pending. Claims 17-20 stand withdrawn from consideration. Claims 33 and 34 are indicated as allowed. Claims 1-13 and 32 are under examination and stand rejected.

By entry of the instant amendment, claims 1-9 and 33-34 will be pending. Claims 10-32 will stand cancelled. Claims 17-20 are cancelled as being drawn to non-elected subject matter. Applicants have further cancelled claims 10-13 and 32 in an effort to advance prosecution. Claims 1-9 stand amended. Support for the amendment to the claims can be found at least in the original claims. Support for the amendment to claim 9 is found, for example, on page 31, lines 26 and 27, and page 32, lines 1-6; and, elsewhere throughout the

specification. Thus, no prohibited new matter is believed to have been introduced by entry of the amendment. The amendments to the claims have been made without prejudice to or disclaimer of the subject matter canceled by way of amendment. Applicants reserve the right to file a divisional or continuation application on any subject matter canceled by way of amendment.

**3. Sequence Rule Non-Compliance Withdrawn**

Applicants acknowledge the withdrawal of the non-compliance with the previously submitted sequence listing.

**4. Specification Informalities and Objections Withdrawn**

Applicants acknowledge the withdrawal of the objections to the specification as a result of the previously filed Amendment.

**5. Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph Withdrawn**

Applicants acknowledge the withdrawal of the rejection of the claims under 35 U.S.C. § 112, second paragraph as a result of the previously filed Amendment.

**6. Rejection of the Claims Under 35 U.S.C. § 102, Second Paragraph Withdrawn**

Applicants acknowledge the withdrawal of the rejection of the claims under 35 U.S.C. § 102(e) as a result of previously filed Amendment and arguments of record.

**7. Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph (Written Description)**

Claims 1-13 and 32 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking written description. The Office repeats the same reasons set forth in the previous Office Action.

Without acquiescing to the merits of the rejection and in an effort to further prosecution, Applicants have cancelled claims 10-13 and 32. With Examiner Baskar's assistance, claims 1-9 have been amended such that the written description rejections have been obviated.

**8. Rejection of the Claims Under 35 U.S.C. § 112, First Paragraph (Enablement)**

Claims 1-13 and 32 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. The Office repeats the same reasons set forth in the previous Office Action.

Applicants have cancelled claims 10-13 and 32. Regarding remaining claims 1-9, Applicants have amended the claims to recited isolated nucleic acid molecules (claims 1 and 9), an isolated cell (claims 2, 7 and 8), and removed reference to fragment (claim 5). The corresponding dependent claims stand likewise amended. Regarding claim 9, a person ordinarily skilled in the art would have little difficulty in making and using the probes set forth in claim 9. It would be a routine practice for a skilled artisan to design and generate probes based on a known sequence (either polynucleotide or polypeptide sequence), because various methods as well as commercial reagent kits are available. Given the interview, Applicants submit that the claim amendments overcome the outstanding enablement rejection. Accordingly, the rejection should be withdrawn, and the claims allowed.

**9. Rejection of the Claims Under 35 U.S.C. § 102**

Claims 1, 5, 9, 10 and 32 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Goh et al, 34 J. CLIN. MICROBIOL. 818 (1996) [hereinafter Goh].

Without acquiescing to the merits of the rejection, Applicants have canceled claims 10 and 32, rendering the rejection as to these claims moot. Regarding remaining claims 1, 5, and 9, Applicants respectfully traverse the rejection.

The Office's rejection rests on an incorrect interpretation of the claims prior to their amendment as containing the transitional phrase "comprising." In Office Action dated November 21, 2005, "[t]he Office is interpreting 'a nucleic acid sequence encoding a *S. epidermidis* polypeptide' as any nucleic acid encoding any *S. epidermidis* polypeptide that is less than the full length polypeptide." See page 17. On the contrary, the correct interpretation of such language would recite a genus of nucleic acid sequences that encode the *full-length* polypeptide. Consequently, the Office arbitrarily uses the *hsp60* sequence from Goh as prior art to reject claims in the current patent application. A sequence comparison would show no significant similarity between the translated *hsp60* sequence and SEQ ID NO: 6352, or between the *hsp60* sequence and SEQ ID NO: 2580. Therefore, the Office has failed to

evince that the claimed nucleic acid sequence is necessarily present in the *hsp60* sequence of Goh. The Office's rejection under 35 U.S.C. § 102(b) does not stand. Reconsideration and withdrawal of the rejection is respectfully requested.

**10. New Rejection Based on Amendment**

Claim 5 stands rejected as being vague and confusing, because the Office alleges it unclear that an isolated nucleic acid fragment of 12 contiguous nucleotides could encode a polypeptide.

Without acquiescing to the merits of the rejection, Applicants amend claim 5 by removing the term "fragment." Applicants submit that such amendment overcomes the rejection. Reconsideration and withdrawal of the rejection is requested.

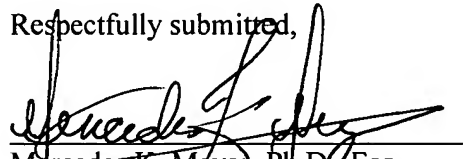
### CONCLUSION

In conclusion, this amendment and reply is believed to be a full response to the outstanding Office Action. Should any issues remain outstanding or if there are any questions concerning this paper, or the application in general, the Office is invited to telephone the undersigned representative at the Office's earliest convenience.

**EXCEPT** for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

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Respectfully submitted,



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